

## **REMARKS**

### **Summary of the Office Action**

Prior to the mailing of the September 12, 2005 Office Action, claims 1-33 were in the application and at issue. In the Office Action, the drawings were objected to under 37 C.F.R. 1.83(a). Claims 5-7, 25, and 33 were objected to. Claims 5, 6, 7, 9, 10, 15, and 25 were rejected pursuant to 35 U.S.C. §112, second paragraph. Claims 1-3, 5, 8-12, 14-17, 20-29, and 31-33 were rejected pursuant to 35 U.S.C. §102. Claims 4, 6, 7, 13, 18, 19, 23, and 24 were rejected pursuant to 35 U.S.C. §103. This paper amends claims 1, 2, 5-7, 11, 16, 19, and 24, cancels claims 4, 9, 10, 15, 18, and 25, and adds new claims 34 and 35. Accordingly, claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-35 are pending.

### **Amendments to the Drawings**

The drawings were objected to under 37 C.F.R. 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner stated the first configuration of the connection must be shown or that feature canceled from the claims. However, Applicants submit this element of the claims is, in fact, shown in the drawings. Alternative configurations of the connection are depicted in FIGS. 1 (first configuration of connection) and 3 (second configuration of connection). It can be appreciated that the use of the adaptor 60 in the second configuration, as shown in FIG. 3, makes the second configuration distinct from the first configuration of FIG. 1.

### **Objected to Claims**

Claims 5-7, 25, and 33 were objected to because the preambles were inconsistent. Claims 5-7 and 33 have been amended to address these inconsistencies, and Claim 25 has been canceled, thus obviating this objection.

### **Rejections Under 35 U.S.C. §112**

Claims 5, 6, 7, 9, 10, 15, and 25 were rejected pursuant to 35 U.S.C. §112, second paragraph. Specifically, Claims 5, 6, and 7 were rejected for insufficient antecedent basis for

“the adaptor body.” The dependency of these claims has been amended so that each now depends from Claim 2 either directly or indirectly. Applicants submit Claims 5-7 now include proper antecedent basis for “the adaptor body” from Claim 2.

Claims 9, 10, 15, and 25 have been canceled obviating the rejection of these claims.

**Rejections Under 35 U.S.C. §102(b)**

Claims 1-3, 5, 8-12, 14-17, 20-29, and 31-33 were rejected under 35 U.S.C. §102(b) as anticipated by Hagstrom (U.S. Patent No. 1,094, 143). Independent Claims 1, 11, and 16 have been amended to include elements not disclosed or suggested by Hagstrom. The amendments to these claims are discussed in detail below.

Independent Claim 26 has not been amended, and Applicants respectfully traverse the rejection of this claim under 35 U.S.C. §102(b). Claim 26 includes, among other things, “a first configuration whereby the axis of the actuator is in alignment with the bolt axis, and a second configuration whereby the axis of the actuator resides a distance away from the bolt access.” This element is not disclosed or suggested by Hagstrom. Only a single configuration is disclosed in Hagstrom. The sole configuration is shown in Figure 2 of Hagstrom, and includes the use of a connecting-arm 53 between the tail-piece 51 and connecting-rod 41. As shown in that Figure 2, the tail-piece 51 is not in the same axis as the connecting-rod 41. No second configuration where the tail-piece 51 and connecting-rod 41 are in the same axis is disclosed or suggested. Furthermore, there is no disclosure or suggestion in Hagstrom indicating how the structure could be modified to meet this element of Claim 26.

In contrast, in Applicants’ Specification, alternative configurations of the connection are depicted in FIGS. 1 (first configuration of connection) and 3 (second configuration of connection). Applicants submit Claim 26 is patentably distinct over the cited art.

Claims 27-33 depend from Claim 26 and include all of the limitations thereof. Therefore, each of claims 27-33 are also patentably distinct from Hagstrom.

New Claim 34 depends from Claim 26 and includes where in the first configuration the axis of the actuator is in longitudinal alignment with the bolt axis. This element is not disclosed or suggested within Hagstrom, and Claim 34 is also in a condition for allowance.

**Rejections Under 35 U.S.C. §103(a)**

Claims 4, 6, 7, 13, 18, 19, 23, and 24 were rejected under 35 U.S.C. §103(a) as obvious in light of Hagstrom.

The elements of dependent Claim 4 have been added to independent Claim 1, and Claim 4 canceled. Amended Claim 1 now includes, among other things, “wherein, the adaptor has a first end with a projection configured for mating connection to the actuator, and a second end with threading configured for mating securement with the extension bolt.” An adaptor having threads is not disclosed or suggested by Hagstrom, and Applicants submit amended Claim 1 is in a condition for allowance.

The Examiner in the Official Action stated that it would have been obvious to one having ordinary skill in the art at the time of the invention to have an adaptor wherein the means for connecting the adaptor to the elongated extension bolt includes an internally and externally threaded fastener arrangement. No reference showing a threaded configuration was cited.

However, the Examiner did cite to the Applicants’ own Specification as grounds for the rejection. Specifically, the Examiner pointed to language in the Specification stating that the adaptor could be made either with or without threading. Also, the Examiner pointed to language in the Specification that disclosed the mating arrangement between the adaptor and extension member could be made either through friction fit or mechanical fitting. By citing to the Applicants’ Specification, the Examiner has clearly relied upon impermissible hindsight in rejecting Claim 4 (now Claim 1).

Applicants submit that the Examiner has not presented a *prima facie* case of obviousness. As such, the rejection is improper. It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the

claim limitations. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Hagstrom does not disclose or suggest the use of a threading configuration. Instead, Hagstrom discloses the use of a tail-piece 51 having an eye-member 52 in which is inserted the connecting-arm 53 of a slide-piece 54. Hagstrom does not disclose or suggest all of the elements of Claim 1. Furthermore, no suggestion, incentive, or motivation to modify the eye-member 52 arrangement is presented in Hagstrom.

Also, the Examiner's interpretation of Applicants' Specification as showing the claimed connection of the two members is obvious is completely misdirected. Applicants correctly listed alternative methods of connecting the adaptor to the extension bolt to fully enable the invention in accordance with accepted patent procedure. Also in accordance with accepted procedure, Applicants are now claiming one of the listed alternatives. It is improper for the Examiner to suggest that because alternatives were listed that one of ordinary skill would find all such alternatives obvious. Applicants did not suggest in the Specification that one having ordinary skill in the art could have determined the claimed connection between the two members without using Applicants' Specification. That is, Applicants provided a detailed description specifically because it would not have been obvious to one of ordinary skill. Therefore, Applicants submit Claim 1 is now in a condition for allowance and request notice to that effect.

Claims 2, 3, and 5-8 each depend from Claim 1 and include all of the limitations thereof. Therefore, each of claims 2, 3, and 5-8 are also patentably distinct from Hagstrom.

Amended independent Claim 11 now includes, among other things, "wherein the adaptor connecting the actuator member and extension bolt is positioned proximate to the central lock assembly." Support for this amendment can be seen in FIGS. 3-6, which clearly show the extension bolt extending to a point proximate to the central lock assembly. This element is not disclosed or suggested in Hagstrom. As shown in FIG. 1 of Hagstrom, the tail-piece 51 is positioned remote and away from the lock assembly, and does not extend any significant distance away from the door sill 50. Indeed, the tail-piece 51 is positioned generally at the door sill 50, and there is not disclosure or suggestion of placing the tail-piece proximate to the central

lock assembly. Therefore, Applicants submit amended Claim 11 is patentably distinct from Hagstrom.

Claims 12-14 depend from Claim 11 and include all of the limitations thereof. Therefore, each of claims 12-14 are also patentably distinct from Hagstrom.

Amended independent Claim 16 has been amended to include the elements of Claim 18, and Claim 18 has been canceled. Amended Claim 16 now includes, among other things, “wherein the means for connecting the second end of the adaptor to the elongated extension bolt includes a threaded fastener arrangement between the adaptor and the extension bolt.” As previously discussed with respect to amended Claim 1, Hagstrom does not disclose or suggest the use of a threaded fastener arrangement between the adaptor and the extension bolt. Applicants submit amended Claim 16 is allowable for the same reasons as amended Claim 1.

Claims 17 and 19-24 depend from Claim 16 and include all of the limitations thereof. Therefore, each of claims 17 and 19-24 are also patentably distinct from Hagstrom.

New Claim 35 includes “wherein the extension bolt extends through the channel between the door frame and proximate to the central lock unit.” Support for this amendment can be seen in FIG. 3 and in the Specification at Page 8, first paragraph. The channel within the door allows the extension bolt to extend from the door frame to a point proximate to the central lock assembly. This element is not disclosed or suggested in Hagstrom. As shown in FIG. 1 of Hagstrom, the tail-piece 51 is positioned away from the lock assembly, and does not extend any significant distance away from the door sill 50. Therefore, Applicants submit new Claim 35 is also patentably distinct from Hagstrom.

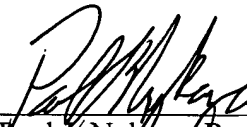
**CONCLUSION**

In view of the above, it is submitted the application is in condition for allowance. Such action is respectfully requested. Further, the Examiner is requested to contact the undersigned if the Examiner has any questions concerning this Reply or if it will expedite the progress of this application.

Respectfully submitted,

Dated: December 12, 2005

By: \_\_\_\_\_

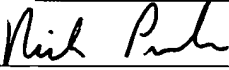
  
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**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on December 12, 2005

  
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